

REMARKS

Reconsideration and allowance are respectfully requested in view of the foregoing amendments and the following remarks.

Upon entry of this Amendment, claims 1, 2, and 4-11 are pending in the application. Claim 3 has been cancelled, claims 1 and 8 have been amended, claims 10 and 11 have been added, and claims 6 and 7 have been withdrawn from consideration.

With respect to the Election of Species Requirement, MPEP § 802.02 states that "Restriction, a generic term, includes the practice of requiring an election between distinct inventions, for example, election between combination and subcombination inventions, and the practice relating to an election between independent inventions, for example, and [sic] election of species." MPEP § 808 states "Every requirement to restrict has two separate aspects: (A) the reasons (as distinguished from the mere statement of conclusion) why the inventions as claimed are either independent or distinct; and (B) the reasons for insisting upon restriction therebetween as set forth in the following sections." (Underlining emphasis added; italicized emphasis original.) In view of the definition of restriction provided in MPEP § 802.02, it is clear that the aspects set forth in MPEP § 808 apply regardless of whether the requirement is an election between distinct inventions or an election of species requirement.

MPEP § 808.01(a) states "Where there is no disclosure of relationship between species (see MPEP § 806.04(b)), they are independent inventions and election of one invention following a requirement for restriction is mandatory even though applicant disagrees with the examiner." MPEP § 808.01 states that "Where the inventions claimed are independent, i.e., where they are not connected in design, operation, or effect under the disclosure of the particular application under consideration (MPEP § 806.04), the facts relied on for this conclusion are in essence the reasons for insisting upon restriction. This situation, except for species, is but rarely presented, since persons will seldom file an application containing disclosure of independent things." (Italicized emphasis in original.)

It is clear from MPEP §§ 808.01 and 808.01(a) that if the Examiner considers the species to be independent, i.e., to have no disclosure of relationship between them, including no connection in design, operation, or effect under the disclosure of the application, then restriction is proper and mandatory. However, MPEP § 808.01 clearly requires that the Examiner rely on facts for this conclusion. There is no indication of any facts relied on by the Examiner for concluding that the plural species are independent. It appears that the Examiner has made a mere statement of conclusion that the plural species of the instant application are patentably distinct as claimed, which as discussed above is improper under MPEP § 808. MPEP § 808 clearly requires the Examiner to provide reasons, or facts in support thereof, why the inventions are independent or distinct as claimed, not mere conclusions.

MPEP § 806.04(b) states "Species, while usually independent, may be related under the particular disclosure. Where inventions as disclosed and claimed are both (A) species under a claimed genus and (B) related, then the question of restriction must be determined by both the practice applicable to election of species and the practice applicable to other types of restrictions such as those covered in MPEP §§ 806.05-806.05(i). If restriction is improper under either practice, it should not be required."

The restriction requirement in the instant application fails to satisfy both aspects of MPEP § 808. The Examiner has provided no reason, or facts in support thereof, why the inventions as claimed are either independent or distinct, substituting instead a mere statement of conclusion, and has provided no reasons for insisting upon the restriction.

In the event that the Examiner considers the plural species to be independent, i.e., to have no disclosed relationship between them, the Examiner should clearly state on the record the facts relied on for such a conclusion, as required by MPEP § 808.01. In the event that the Examiner considers the species to be related, then the Examiner should clearly state such on the record and perform the analysis for restriction between related inventions required by MPEP §§ 806.05+ and provide the reasons for insisting upon restriction as required by MPEP § 808.02.

It is also respectfully submitted that the subject matter of all of the species is sufficiently related that a thorough search and examination for the subject matter of any one species would necessarily encompass the search and examination of the remaining species. The application can thus be searched and examined without serious burden. MPEP § 803 sets forth the criteria for a proper requirement for restriction: (A) the inventions must be independent or distinct as claimed; and (B) there must be a serious burden on the examiner. As also stated in MPEP § 803, "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." (Emphasis added.) As discussed above, as MPEP § 802.02 defines restriction as both restriction between distinct inventions and election of species requirements, it is clear that the requirement of a serious burden applies regardless of the nature of the restriction requirement.

As the election of species requirement fails to satisfy both aspects of MPEP § 808, i.e., fails to provide any reasoning why the inventions as claimed are either independent or distinct, and any reason for insisting upon restriction, and fails to satisfy the criteria of MPEP § 803, i.e., fails to establish that the application includes independent or distinct inventions as claimed and that a serious burden exists, it is respectfully submitted that the election of species requirement is improper and should be withdrawn.

With respect to the assertion on page 2 of the Office Action that "Applicant's response implies that the various species are not considered to be patentably distinct," it is respectfully noted that current Patent Office policy requires that should Applicants traverse

on the grounds that the species are not patentably distinct, then Applicants should clearly state on the record that such is the case. As Applicants have not clearly stated such, then such is not the case.

Figures 1, 11 and 12 have been amended in response to objections noted by the Examiner. The amendments to these Figures, indicated in red, are submitted under a separate Drawing Change Authorization Request attached hereto. It is respectfully requested, therefore, that the objection to the drawings be withdrawn.

The Abstract has been amended in response to objections noted by the Examiner. It is respectfully requested, therefore, that the objection to the Abstract be withdrawn.

Claims 1-5, 8 and 9 are rejected under 35 U.S.C. §112, second paragraph. Claim 1 has been amended for clarity purposes in order to overcome this rejection. Claim 3 has been cancelled, so the rejection of this claim is moot. It is respectfully requested, therefore, that this rejection be withdrawn.

Claims 1-5, 8 and 9 are rejected under 35 U.S.C. §102(b) by British Patent Publication No. 2 312 460 (the '460 publication). This rejection is respectfully traversed.

Claim 1 is directed to a trim and glass run attachment structure in a vehicle door including a flange provided on a window frame of the vehicle door, a U-shaped attachment groove provided by a door exterior side and an outer circumferential side of the flange at a root portion thereof, a lock protrusion strip provided on a door interior side wall of the attachment groove at the root portion of the flange, a trim having a substantially U-shaped section and attached to the flange, and a glass run formed separately from the trim having a glass run body attached into the attachment groove. The glass run body has a lock protrusion strip engaging with the lock protrusion strip of the attachment groove to retain the glass run body in the groove. A part of the trim is in contact with the glass run, when the trim is attached to the flange. A door exterior part of the flange and a door interior part of the attachment groove are integrally formed as a single component. The flange and attachment groove are formed in series from a door interior to a door exterior, so that the flange does not form a wall of the attachment groove.

The '460 publication does not disclose the trim and glass run attachment structure in a vehicle door as recited in claim 1. As best shown in Figure 3 of the '460 publication, the window frame includes a channel 44 defined by flanges 44A and 44B. The flange 44B that the extruded structure 54 is mounted to also provides a side wall for the channel 44 in which the molded part 40 is mounted. Thus, the '460 publication does not disclose a flange provided on a window frame of the vehicle door and a U-shaped attachment groove provided by a door exterior side and an outer circumferential side of the flange at a root portion thereof, wherein the flange and attachment groove are formed in series from a door interior to a door exterior, so that the flange does not form a wall of the attachment groove, as recited in claim 1.

Withdrawal of the rejection of claim 1 is respectfully requested.

Claims 2 and 4-9 are allowable by virtue of their dependence on claim 1 and for their recitation of additional patentable subject matter.

New claims 10 and 11 have been added. These claims are allowable by virtue of their dependence on claim 1 and for their recitation of additional patentable subject matter. For example, the '460 publication does not disclose that the glass run body includes opposing side walls that provide a pair of seal lips, the pair of seal lips structured to engage opposing sides of a window glass, as recited in claim 11. In contrast, the '460 publication discloses lips 60 and 62 provided on the extruded structure 54 that is mounted to flange 44B.

All rejections and objections have been addressed. It is respectfully submitted that the present application is now in condition for allowance, and notice to that effect is earnestly solicited.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached Appendix is captioned "Version With Marking to Show Changes Made."

Should there be any questions or concerns regarding this application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,

PILLSBURY WINTHROP LLP



John P. Darling
Reg. No. 44,482
Tel. No. (703) 905-2045
Ian G. Schutter
Reg. No. 51,094
Tel. No. (703) 905-2177

1600 Tysons Boulevard
McLean, VA 22102
(703) 905-2000
Fax No. (703) 905-2500

APPENDIX

Version With Marking to Show Changes Made

IN THE ABSTRACT:

The Abstract is amended as follows:

A window frame is constituted by an inner panel, an outer panel and a door sash which are formed by press molding, and a glass run body of a glass run is attached and locked in an attachment groove provided in the door sash. A trim formed separately from the glass run is [fitted] attached to an interior flange of the inner panel and an interior flange of the door sash so that an exterior holding lip of the trim is brought into pressure contact with an interior holding lip provided on the glass run. A door glass is [held to be able] adapted to be guided to slide by seal lips of the glass run. The interior flange and the attachment groove are integrally formed [in a common] as a single component and the relative positions of these two parts are kept stable.

IN THE CLAIMS:

Claim 3 has been cancelled.

Claims 1 and 8 have been amended as follows:

1. (Amended) A trim and glass run attachment structure in a vehicle door, comprising:
 - a flange [formed] provided on a window frame of the vehicle door;
 - a [channel-like] U-shaped attachment groove provided [outward at] by a door exterior side and an outer circumferential side of said flange at a root portion thereof;
 - a lock protrusion strip provided on a door interior side wall of said attachment groove at the root portion of said flange;
 - a trim having a substantially U-shaped section and attached to said flange; and
 - a glass run formed separately from said trim, having a glass run body [to be] attached into said attachment groove;
 - said glass run body having a lock protrusion strip engaging with the lock protrusion strip of the attachment groove to retain the glass run body in said groove;
 - wherein a part of said trim is in contact with said glass run, when said trim is attached to said flange;
 - wherein a door exterior part of said flange and a door interior part of said [channel-like] attachment groove are integrally formed [in a common] as a single component, and wherein the flange and attachment groove are formed in series from a door interior to a door exterior, so that the flange does not form a wall of said attachment groove.

8. (Amended) A trim and glass run attachment structure in a vehicle door according to Claim 1, wherein said window frame is constituted by an inner panel, an outer panel or a molding member, and a door sash as said [common] single component; and wherein said flange is formed in a car-interior-side connection portion between said inner panel and said door sash, and said [channel-like] attachment groove is formed on an outer circumferential side from root portions of said flange.

New claims 10 and 11 have been added.

ABSTRACT

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A window frame is constituted by an inner panel, an outer panel and a door sash which are formed by press molding, and a glass run body of a glass run is attached and locked in an attachment groove provided in the door sash. A trim formed separately from the glass run is attached to an interior flange of the inner panel and an interior flange of the door sash so that an exterior holding lip of the trim is brought into pressure contact with an interior holding lip provided on the glass run. A door glass is adapted to be guided to slide by seal lips of the glass run. The interior flange ^{of the door sash} and the attachment groove are integrally formed as a single component and the relative positions of these two parts are kept stable.